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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

OMS Investments, Inc.

v.

Central Garden & Pet Company

Opposition No. 91156249 to application Serial No. 76300626
filed on August 17, 2001

Cory M. Amron and William H. Oldach III of Vorys, Sater, Seymour and Pease LLP, for OMS Investments, Inc.

Diane J. Mason of Dorsey & Whitney LLP for Central Garden & Pet Company.

Before Rogers, Zervas and Walsh, Administrative Trademark Judges.

Opinion by Zervas, Administrative Trademark Judge:

Applicant, Central Garden & Pet Company, seeks registration on the Principal Register of the mark EASYGONE[1] (in standard character form) for the following goods:

[1] Application Serial No. 76300626, filed August 17, 2001.

"herbicides and insecticides for agricultural and domestic use" in International Class 5. The application contains an allegation of a date of first use and first use in commerce of December 13, 2000.

OMS Investments, Inc. ("opposer" or "OMS") filed a notice of opposition to registration of applicant's mark. In the notice of opposition, opposer pleaded use of "numerous trademarks containing the term 'B-GON'" "since long prior to Applicant's filing date of August 17, 2001"; and ownership of the following registrations and marks:

> PEST-B-GON, Registration No. 433172, registered September 30, 1946, for "parasiticides - namely, insecticides";[2]
>
> WEED-B-GON, Registration No. 903317, registered December 1, 1970, for "herbicides";[3]
>
> BRUSH-B-GON, Registration No. 1301169, registered October 23, 1984 for "[p]esticide - [n]amely [h]erbicide";[4]
>
> GRASS-B-GON (stylized), Registration No. 1995777, registered August 20, 1996, for "pesticides and herbicides for home and garden use";[5]
>
> BUG-B-GON, Registration No. 2073033, registered June 24, 1997, for "insecticides for home and garden use";[6]

[2] Renewed September 30, 1987.
[3] Renewed March 26, 2001.
[4] Renewed October 22, 2004.
[5] Section 8 and Section 15 affidavits accepted and acknowledged, September 19, 2001.
[6] Section 8 and Section 15 affidavits accepted and acknowledged, September 10, 2003.

WEED-B-GON, Registration No. 2088157, registered August 12, 1997, for "herbicides mixed with fertilizers for domestic use";[7]

BIRD-B-GONE (and design), Registration No. 2562771, registered April 23, 2002, for "pest repellent devices, namely, a metal architectural barrier for preventing birds from landing and perching," in International Class 6, and "pest repellent devices, namely, a non-metal architectural barrier for preventing birds from landing and perching" in International Class 19; and

ANT-B-GON (stylized), Registration No. 2646066, registered November 5, 2002, for "insecticides for agricultural and domestic use."

Additionally, opposer asserted the following registrations and marks - the registrations have since been cancelled:

WEED-B-GON, Registration No. 889348, for "aspirator type spray gun devices for chemical pesticides," cancelled April 28, 2001;

FLEA-B-GON, Registration No. 1261432, for "insecticide – [n]amely [f]lea-[k]iller," cancelled September 25, 2004;

WEED-B-GON EXTRA GREEN, Registration No. 2074449, for "herbicide mixed with fertilizer for domestic use," cancelled March 27, 2004; and

GRUB-B-GON, Registration No. 2236054, for "insecticides for residential and agricultural use," cancelled January 7, 2006.

Opposer has also alleged that its marks form a family of B-GON marks which "identify a line of products for controlling various types of pests both inside the home and for outdoor use"; and that applicant's mark so resembles

[7] Section 8 and Section 15 affidavits accepted and acknowledged,

opposer's previously used and registered marks as to be likely to cause confusion, to cause mistake, or to deceive. Trademark Act Section 2(d), 15 U.S.C. §1052(d). Additionally, opposer alleges that the "use and registration of EASYGONE by Applicant will dilute the distinctive value of Opposer's line of 'B-GON' marks and products …."

Applicant answered the notice of opposition by denying the salient allegations thereof.

The Record

The record consists of the pleadings; the file of the involved application; the trial testimony, with related exhibits, taken by opposer, of (i) Giancarlo Miranda, brand manager, The Scotts Company; and (ii) John Brex, formerly President of Excel Marketing and now a consultant for applicant; the trial testimony, with related exhibits, taken by applicant of (i) Fred Vogelgesang, President of Excel Marketing, a division of applicant; (ii) Carl Yeager, a business manager for applicant; (iii) Richard Wall, owner of Wall and Associates, a consultant for applicant; and (iv) Sandra Cogan of Cogan Research Group, who conducted a survey on applicant's behalf; and, pursuant to applicant's notices of reliance, excerpts from the discovery deposition of Mr. Miranda, opposer's responses to certain interrogatory requests made by applicant, and third-party trademark

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September 13, 2003.

applications and registrations incorporating the formative "BE-GONE" or "B-GONE."

The parties have fully briefed the opposition. An oral hearing was conducted on February 9, 2006.

Factual Findings

Opposer is an affiliate of The Scotts Miracle-Gro Company, formerly named The Scotts Company. Miranda tr. at p. 15.[8] In 1999, Scotts acquired a line of pesticide and herbicide products – known as the Ortho line - from its former owner Monsanto. The following are marks that are a part of the Ortho line and were acquired from Monsanto; BRUSH-B-GON, BUG-B-GON, GRASS-B-GON, and WEED-B-GON and an application for ANT-B-GON. Miranda tr. at p. 8; and Miranda Exhibit 1.

Opposer's B-GON pesticide and herbicide products are sold nationwide, in home centers, mass merchandisers, hardware stores, and nurseries and through independent distributors. Miranda tr. at p. 20. The B-GON products can be found at The Home Depot, Lowe's, Wal-Mart, K-mart, Target, Ace Hardware, TruServ, Do It Best and other retailers. Miranda tr. at pp. 20-22, 25-30. Sales of some of opposer's B-GON products have been significant, as have

[8] While Mr. Miranda testified that opposer is an affiliate of The Scotts Company, opposer contends at p. 9 of its brief that The Scotts Company changed its name subsequent to Mr. Miranda's deposition to The Scotts Miracle-Gro Company.

amounts spent in advertising some of such products. Miranda tr. at pp. 33-36 and 54-56.

Applicant was the primary national distributor of B-GON products sold by Monsanto prior to the 1999 acquisition of the Ortho line by The Scotts Company. Miranda tr. at p. 42. After The Scotts Company acquired the Ortho line, the distributor relationship was terminated.[9] Miranda tr. at p. 43.

In 1996, applicant "adopted a corporate strategy to manufacture and distribute more of its own products, instead of primarily distributing products of other companies." Vogelgesang tr. at pp. 47-50. Applicant created a division named Excel Marketing to help applicant build its line of proprietary brands. Brex tr. at p. 76. Excel Marketing developed, inter alia, a "value line" of products, i.e., "value" products which are cheaper than "name brand" products such as Ortho products. Vogelgesang tr. at pp. 43, 45 and 49; Brex tr. at p. 11; and Wall tr. at pp. 15, 71–72.

Part of applicant's process for developing a "value line" of products included a name generation project. Exhibit 5 to Wall tr. at pp. DEF 00443, 0459; Exhibit 7 to Wall tr. at p. DEF 0350. In 1997, applicant retained Mr.

[9] According to Mr. Yeager, applicant stopped distributing Ortho products in "approximately August of 2000." Yeager tr. at p. 63.

Wall as a consultant to develop brand names for applicant's new line of lawn and garden chemical products. Wall tr. at pp. 12 – 14. With the assistance of professional naming companies hired by applicant, the term "easygone" was "generated" as were many others such as "maxide." Wall tr. at p. 21; Exhibit 5 to Wall tr. at p. DEF 00468. Applicant screened many of such names internally to "whittle them down" by conducting consumer focus groups known as "I-PARs." Wall tr. at p. 26, Vogelgesang tr. at pp. 77–79 and 99. Additionally, applicant's trademark attorney commissioned a Thomson & Thomson ("T&T") search for the six top marks generated by the naming companies, which included a search for "EASY GON," and which was reviewed by the trademark attorney. Opposer's Exhibit 8 (T&T report); Wall tr. at pp. 27, 28, 33 and 34. Subsequently, in "approximately 1999," applicant had discussions with Orchard Supply Hardware ("OSH"), a retailer with approximately eighty-five stores in California and Nevada, regarding developing a value brand of consumer herbicides and insecticides for sale in OSH stores. Brex tr. Exhibit 21, p. 49; Yeager tr. at p. 62; Vogelgesang tr. at p. 11, 25 and 35. OSH was offered a choice of marks and chose EASYGONE. Brex tr. at p. 52. Mr. Brex, president of Excel Marketing at the time, approved OSH's choice. Brex tr. at p. 52. In December 2000, applicant launched EASYGONE

herbicides and insecticides. Yeager tr. at p. 18; and Yeager Exhibit 2.

Preliminary Matters

Before addressing the merits of this case, we must consider several objections raised by applicant.

First, applicant has objected "to any reliance by OMS on the registration of the mark PEST-B-GON for any purposes including, but not limited to, any attempt by OMS to show that it has a family of marks." According to applicant, Mr. Miranda testified that opposer "no longer sells or distributes any product under the name PEST-B-GON … [and] that he had no personal knowledge of PEST-B-GON products." Brief at p. 12.

Opposer has not introduced a status and title copy of the PEST-B-GON registration into the record, nor offered any testimony on its existence, ownership or renewal. Accordingly, the registration is not in evidence and we give no further consideration to opposer's claim of ownership of a registration for PEST-B-GON. Applicant's objection on the basis of non-use of the mark is moot.

Second, applicant has objected to the statement "[a]round this time, Central Garden [applicant] began to explore the possibility of marketing its own brands of pest control products, in part to recoup some of the revenue it lost as a result of the Ortho transaction" found on p. 11 of

opposer's brief. Applicant maintains that "there is no evidence that Central Garden [applicant] explored marketing its own brands of pest control products for the reason of recouping 'some of the revenue it lost as a result of the Ortho transaction.'" Brief at p. 12.

Because there is no evidence to support opposer's contention, applicant's objection is sustained to the extent that we consider the statement on p. 11 of opposer's brief only for the argument that it is.

Third, applicant objects on the basis of hearsay to the document entitled "Review and Analysis of This Report" by Dr. Carl E. Block as Opposer's Exhibit 11 to the deposition of Dr. Cogan.[10] According to applicant, opposer "did not lay a foundation for admitting the report by deposing Dr. Block." Thus, applicant maintains, opposer "should not be allowed to refer or rely on Opposer's Exhibit 11 for any purpose." Brief at p. 13.

Opposer responds that "[t]he Block report is intended as an impeachment exhibit [and] Applicant itself did submit into evidence the rebuttal report prepared by [Dr.] Cogan in response to the Block report. As the Cogan rebuttal in most cases repeats the assertions in the Block report in order to

[10] The "Review and Analysis" addresses Dr. Cogan's report regarding a survey she performed on applicant's behalf in support of its contention that there is no likelihood of confusion between opposer's marks and applicant's mark. See discussion, *infra*.

rebut them, this is a largely hollow debate." Reply at fn. 1, p. 18.

Applicant's objection to Exhibit 11 on the basis of hearsay is sustained. Because neither party has taken the testimonial deposition of Dr. Block, the material in the report is hearsay. We have not considered the Block report in rendering our decision herein.

Priority

Applicant states in its brief that it "concedes that some of OMS' [opposer's] marks, such as WEED-B-GON and BUG-B-GON, have priority of use." Brief at p. 13. Also, opposer has entered into evidence a status and title copy of Registration Nos. 2073033, 1995777, 1301169 and 2646066 for the marks BUG-B-GON, GRASS-B-GON (stylized), BRUSH-B-GON and ANT-B-GON (stylized), respectively, and Mr. Miranda has testified that opposer is the owner of such registrations. Miranda tr. at pp. 16 – 19.[11] In view thereof, Section 2(d) priority of use is not an issue in this case as to WEED-B-GON, BUG-B-GON, BRUSH-B-GON, GRASS-B-GON and ANT-B-GON (hereinafter, "the involved marks.") *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

[11] Opposer entered a status and title copy of Registration No. 889348 for WEED-B-GON into the record. However, on April 28, 2001, Registration No. 889348 expired because it was not renewed. We therefore give no further consideration to Registration No. 889348.

Likelihood of Confusion

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence that are relevant to the factors bearing on the issue of likelihood of confusion. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

The salient question to be determined is not whether the involved goods of the parties are likely to be confused, but rather whether there is a likelihood that the relevant purchasing public will be misled to believe that the goods offered under the involved marks originate from a common source. See *J.C. Hall Company v. Hallmark Cards, Inc.*, 340 F.2d 960, 144 USPQ 435 (CCPA 1965); *The State Historical Society of Wisconsin v. Ringling Bros.-Barnum & Bailey Combined Shows, Inc.*, 190 USPQ 25 (TTAB 1976).

The Goods

We first examine the similarities or dissimilarities of the parties' goods, considering the goods as they are described in the identification of goods in the applicant's application and opposer's registrations. See *Paula Payne Products Co. v. Johnson Publishing Co*., Inc., 473 F.2d 901, 177 USPQ 76 (CCPA 1973). Applicant's "herbicides … for agricultural and domestic use," are encompassed within opposer's identifications for GRASS-B-GON ("pesticides and herbicides for home and garden use") and BRUSH-B-GON ("pesticide – [n]amely, [h]erbicide"). Also, applicant's herbicides are identical to opposer's WEED-B-GON product, which Mr. Miranda has characterized as a product that "kills weeds in lawns without harming the lawn." Further, applicant's "insecticides for agricultural and domestic use" are encompassed within opposer's identifications for BUG-B-GON ("insecticides for home and garden use") and identical to ANT-B-GON ("insecticides for agricultural and domestic use"). We therefore resolve this factor in opposer's favor.

Trade Channels

Given the absence of any restrictions or limitations in the parties' respective identifications of goods in the application and the registrations, the parties' herbicides and insecticides are deemed to be marketed in the same trade channels and to the same classes of purchasers. *Kangol Ltd.*

v. KangaROOS U.S.A. Inc., 974 F.2d 161, 23 USPQ2d 1945 (Fed. Cir. 1992). Such trade channels include retail home improvement, hardware and garden centers. Indeed, Mr. Yeager has testified that EASYGONE products are sold at OSH and that "Ortho Products [are] also sold at Orchard Supply Hardware"; and that one would expect that BUG-B-GON and WEED-B-GON to be placed on the shelves at OSH in close proximity to the EASYGONE products. Yeager tr. at pp. 13 - 15. Thus, the parties' goods, in fact, travel through the same channels of trade. This factor hence is resolved in opposer's favor.

The Marks

We next consider the similarities and dissimilarities of the parties' marks. We must determine whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). A "[s]ide by side comparison is not the test." *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573 (CCPA 1973). The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975).

It is apparent that both marks contain three syllables, with GON or GONE forming the last syllable and word in the marks. The middle syllable in each mark forms a letter ending with an "ee" sound, i.e., the letter "b" in the case of opposer's marks and the letter "z" in the case of applicant's mark. Opposer correctly notes that the marks have a similar cadence and do rhyme with one another. Thus, when considering the marks as a whole, there clearly are similarities in sound. Further, the marks are similar in connotation and commercial impression in that they suggest that the lawn or garden problem facing the purchaser will terminate through the use of the parties' goods.[12] Thus, while there may be differences in the appearance and meaning of the marks through the initial wording in the marks, the overall similarities in sound, meaning and commercial impression due to the remaining portions of the marks outweigh such differences.

Opposer, in its main brief at p. 15, argues that "the final and most dominant syllable in the marks is the term

[12] In this regard, we reject applicant's argument regarding differences in connotation of the marks; i.e., that consumers associate EASYGONE with an easy to use product while opposer's marks communicate that use of its products will result in a specific problem being eliminated. The distinction in the connotations of the marks advanced by applicant is too subtle and likely would be lost on prospective purchasers of the parties' products - the typical consumer will not likely study the marks' connotations to discern such differences. As noted above, the focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Id*.

GON or GONE."[13] Applicant disagrees, and argues that the first word or prefix in a mark is usually given greater weight as the dominant feature; and that "'GON' is descriptive of opposer's goods in that it informs the customer exactly what the products will do." Brief at pp. 15 - 16. Further, according to applicant, "[g]iven the inherent weakness of the suffix 'B-GON,' the prefix of the marks … would be given greater weight as the dominant feature of the respective marks."[14] Brief at p. 17.

Certainly, the terms WEED, BUG, BRUSH, GRASS and ANT identify the problem which the goods are intended to eliminate, and hence are descriptive of a feature of the goods. B-GON communicates that the problem will be eliminated or "gone" with opposer's goods and is suggestive of a result one would achieve in using the goods. Thus, the

[13] We note that in its reply at p. 6, opposer states that "B-GON is the dominant feature of Opposer's marks." Our analysis is the same whether it is opposer's contention that GON or B-GON is the dominant portion of the mark.

[14] Applicant also argues that GON or B-GON is "weak" and is "descriptive of the associated goods … as it informs the customer exactly what the products will do" in view of the twenty-two third-party registrations in evidence for marks that include B GONE or BE GONE. Brief at p. 15. We acknowledge that "[t]hird-party registrations are probative evidence of the meaning of a word, in the same way that a dictionary can be used … [and that] third-party registrations of composite marks including an allegedly descriptive term can be used to help prove the descriptive nature of that term." 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, 11:69 (4th ed. database updated 2006). None of the registrations includes a disclaimer of GONE, B GONE or BE GONE and none of the goods set forth in the registrations is in the nature of opposer's goods. Thus, we are not persuaded that GON or B-GON is descriptive or weak in the context of opposer's goods.

dominant portion of opposer's marks is B-GON. EASYGONE suggests a result that one would achieve – that something will be "gone" - and the manner the result is achieved, i.e., with ease. In our view, neither EASY nor GONE is dominant over the other.

In view of the foregoing, and mindful that "[w]hen marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines," *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), we resolve this *du Pont* factor regarding the similarities of the marks in opposer's favor.

Conditions Under Which and Buyers to Whom Sales Are Made

Opposer maintains that both applicant's and opposer's goods are "rather inexpensive and are subject to the same sort of impulse buying by consumers as occurs with food and related grocery items." Brief at p. 16. Opposer adds that when goods are low in price and subject to impulse buying, the risk of likelihood of confusion is increased, citing, inter alia, *Recot Inc. v. Becton*, 214 F.3d 1322, 54 USPQ2d 1894 (Fed. Cir. 2000). Brief at p. 16.

Applicant, on the other hand, points out that opposer's and applicant's products are "all chemical products used as pesticides around consumers' lawn and gardens"; and that

"[c]onsumers will spend a long amount of time studying pesticide product labels." Brief at pp. 19-20. Consequently, applicant concludes that "consumers are unlikely to be confused by the co-existence of EASYGONE with Opposer's marks." *Id*. at p. 20.

However, even if a prospective purchaser is careful in choosing a pesticide product and spends time studying the product labels, it does not follow that he or she will also examine the trademarks on the product. Also, there is a dearth of record evidence on this factor, and we are unaware of any precedent that discusses the conditions under which and buyers to whom sales are made for goods of the type involved in this proceeding. Therefore, we do not resolve this factor in either party's favor but rather consider it neutral.

Family of Marks

The family of marks doctrine applies in situations where the plaintiff had established a group of marks characterized by a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but the common characteristic of the family, with the trademark owner. See *J & J Snack Foods Corp. v. McDonald's Corp*., 932 F.2d 1460, 18 USPQ2d 1889 (Fed. Cir. 1991).

It is well settled that merely adopting, using and registering a group of marks having a feature in common for similar goods or related goods or services is insufficient to establish, as against a defendant, a claim of ownership of a family of marks characterized by the feature. Rather, it must be demonstrated that prior to defendant's first use of its challenged mark, the various marks said to constitute the family, or at least a good number of them, were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic. *Id*., 18 USPQ2d at 1891. See also *Hester Industries Inc. v. Tyson Foods Inc*., 2 USPQ2d 1646 (TTAB 1987); *Cambridge Filter Corp. v. Sensodyne Corp*., 189 USPQ 99 (TTAB 1975). "It is thus necessary to consider the use, advertisement, and distinctiveness of the marks, including assessment of the contribution of the common feature to the recognition of the marks as of common origin." *J & J Snack Foods,* 18 USPQ2d at 1891.

In support of its assertion that it has a family of marks, opposer relies on the following testimony from Mr. Miranda at pp. 39 – 40 of his trial deposition:

> Q. Have there been displays constructed by The Scotts Company for advertising its B-Gon family of marks and products since 1999 that display, in fact, the full family or a portion of the full family of B-Gon products?
>
> A. Yes.

Opposer also maintains that applicant itself has recognized "that the B-GON marks constitute a family," relying on Exhibit 10 of Mr. Vogelgesang's testimonial deposition, i.e., a document prepared by Mr. Yeager for a presentation, entitled "Orchard Supply Hardware Easy Gone Development Project," stating "Presented August, 2003," which applicant produced in discovery. Brief at p. 20; Vogelgesang tr. at pp. 87, 93. The document "discusse[s] whether or not consumers had confusion between EASYGONE and the "B-GON products," brief at p. 20, and states in relevant part: "[w]ith rare exceptions the name is not associated with the Ortho brand, nor does there appear to be any confusion in consumers' minds between Easy Gone products and '-B-Gon' products." Exhibit 10, Vogelgesang dep., p. 10.5.

In this case, the record does not show that the B-GON marks were used and promoted together in such a manner as to create among purchasers an association of common ownership based upon the family characteristic, i.e., B-GON. Mr. Miranda, who was also opposer's Fed. R. Civ. P. 30(b)(6) witness, stated in his discovery deposition that BUG-B-GON has always been advertised alone and never with any other products; that WEED-B-GON has not been advertised with any of opposer's other B-GON products; that he was not aware if WEED-B-GON and BUG-B-GON were ever advertised together in radio or television advertisements; and that he was not

aware of any end-aisle displays that featured more than one B-GON product together. See applicant's first notice of reliance (filed November 22, 2004), Miranda discovery dep. at pp. 80-83, 90-94. Further, even if the displays Mr. Miranda mentioned in his testimonial deposition promoted several members of the alleged family of marks concurrently, there is no testimony as to how frequently such displays have been used, where in stores such displays are set up or how many people viewed such displays. Also, the statement in the material Mr. Yeager included in his presentation materials to OSH can hardly be considered an admission or acknowledgement on applicant's part that opposer's asserted marks constitute a family of marks – the statement only references "–B-Gon" products. The statement does not include the term "family" and says nothing about use and promotion of the marks in such a manner as to create an association among purchasers of common ownership based upon the common characteristic.

Thus, opposer has not met its burden of establishing that a family of marks exists in this case. As applicant has pointed out, simply using a series of similar marks does not of itself establish the existence of a family. Brief at p. 22.

Fame of Opposer's Marks

The Federal Circuit, our primary reviewing court, has stated that fame of the prior mark plays a dominant role in cases featuring a famous or strong mark. *Century 21 Real Estate,* 23 USPQ2d 1701, quoting, *Kenner Parker Toys v. Rose Art Industries*, 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992). "[A] mark with extensive public recognition and renown deserves and receives more legal protection than an obscure or weak mark." *Id.,* 22 USPQ2d at 1456. "[F]ame of a mark may be measured indirectly, among other things, by the volume of sales and advertising expenditures of the goods traveling under the mark, and by the length of time those indicia of commercial awareness have been evident." *Bose Corp. v. QSC Audio Products, Inc*., 293 F.3d 1367, 63 USPQ2d 1303 (Fed. Cir. 2002). When the statistics of sales and advertising as indicia of fame are large, the Federal Circuit has tended to accept them without any further supporting proof. *Id.*, 63 USPQ2d at 1306.

In support of its contention that opposer's B-GON marks are famous, opposer relies on Mr. Miranda's trial testimony. Mr. Miranda testified to opposer's (i) annual sales revenue for the 1997/1998 time period for B-GON products when applicant was distributing B-GON products;[15] (ii) average yearly revenue of opposer's B-GON products; and (iii) sales revenue for 2003 for each of the WEED-B-GON, BUG-B-GON,

MOSQUITO-B-GON, GRASS-B-GON, BRUSH-B-GON and ANT-B-GON products.[16] Miranda tr. at pp. 32-34. Mr. Miranda also testified that opposer primarily advertises its BUG-B-GON and WEED-B-GON marks on television, but also advertises them on the radio and in print;[17] that opposer's television and radio advertising commenced in 1999; and to the amounts opposer has spent annually in national television advertising and radio advertising. Miranda dep. at p. 81; Miranda tr. at pp. 34 – 36.[18] Further, Mr. Miranda has testified that opposer has commenced several legal proceedings involving the B-GON marks to protect the strength of the marks. Miranda tr. at pp. 46 – 47.

Because opposer has not established that it has a family of marks, we consider whether each of the involved marks is famous. After carefully considering the evidence of record, particularly the sales revenue, advertising expenditures and duration of use testified to by Mr.

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[15] As mentioned earlier in this decision, opposer acquired the B-GON marks from Monsanto in 1999.

[16] Opposer maintains that its revenue and advertising figures are confidential. Thus, they are not set forth in our decision.

[17] Mr. Miranda testified that opposer's print advertising has been in local newspapers and "run of press."

[18] Mr. Miranda stated that "displays set up in stores" are another form of advertising of the B-GON marks; that from 1999 to 2004, applicant set up displays in Home Depot, Lowe's, Wal-Mart and other chains, and that the displays are for WEED-B-GON, BUG-B-GON, BRUSH-B-GON, GRASS-B-GON, ANT-B-GON, and other B-GON products. Miranda tr. at pp. 38 - 39. For the reasons discussed earlier in this decision regarding opposer's displays, its displays are accorded limited weight in our determination of whether opposer's marks are famous.

Miranda, we find that there is evidence of some fame, but only of the WEED-B-GON mark. See *Palm Bay Imports*, 73 USPQ2d at 1691 ("likelihood of confusion fame varies along a spectrum from very strong to very weak.") The record reflects use of WEED—B-GON on herbicides "going back to the early 1990s,"[19] Miranda tr. at p. 54, and the sales and advertising figures are of a size comparable to sales and advertising figures in other cases where fame has been found. See, e.g., *Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc.,* 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989) (NINA RICCI for perfume, clothing and accessories: $200 million in sales, over $37 million in advertising over 27 years); *Kimberly-Clark Corp. v. H. Douglas Enter., Ltd.,* 774 F.2d 1144, 227 USPQ 541 (Fed. Cir. 1985) (HUGGIES for diapers: over $300 million in sales over 9 years, $15 million in advertising in one year); *Specialty Brands Inc. v. Coffee Bean Distribs., Inc.,* 748 F.2d 669, 223 USPQ 1281 (Fed. Cir. 1984) (SPICE ISLANDS for teas, spices and seasonings: $25 million annually in sales for spices, $12 million between 1959 and 1981 for tea, "several million" in advertising, in use for 40 years); *Planters Nut & Chocolate Co. v. Crown Nut Co.,* 305 F.2d 916, 134 USPQ 504 (CCPA 1962) (MR. PEANUT

[19] As noted earlier, we do not consider the registration asserted by opposer for WEED-B-GON which opposer alleges was registered in 1970 because the record does not contain a copy of the registration that has been suitably authenticated.

DESIGN for nuts and nut products: $350 million in sales, $10 million in advertising over 10 years). We thus need not resort to other indicia of fame, such as market share, critical acclaim or survey evidence. As for BUG-B-GON, the evidence of record reflects that even though the mark has been in use since 1983, roughly twenty years ago,[20] BUG-B-GON has not generated the sales revenue that WEED-B-GON has generated. Also, there is no evidence of record regarding BUG-B-GON's market share or critical acclaim of BUG-B-GON, or of a survey that supports opposer's assertion of fame of the BUG-B-GON mark. Thus, on the record in this case, we do not conclude that BUG-B-GON is a famous mark. However, the sales revenue and advertising expenditures have been sufficient to establish that BUG-B-GON mark is a strong, well-known mark. As for opposer's remaining involved marks, the underlying goods have not enjoyed nearly the same sales revenue as the sales revenue for either WEED-B-GON or BUG-B-GON, and are not advertised other than at the point of purchase. See Miranda discovery deposition at p. 81. Thus, on this record, we do not find that such marks, namely,

[20] Opposer maintains in its brief that "the B-GON line of products dates back to at least as early as 1945, when the first B-GON mark (PEST-B-GON) was registered by Opposer's predecessor-in-interest." Brief at p. 17. While applicant's attorney's representation may be true, because opposer has not introduced evidence as to the first use dates of any of the B-GON marks in issue, opposer is limited to claiming the filing date of the applications for the marks in issue.

GRASS-B-GON, BRUSH-B-GON and ANT-B-GON, are famous or even well-known.

Applicant has challenged the evidence on which opposer relies in arguing that its marks are famous, maintaining that "[f]ame of a mark is shown by evidence of advertising figures, sales, market share, and survey evidence regarding recognition of a mark"; that "[s]ales numbers alone are not sufficient to establish the fame of a mark"; and that applicant "did not introduce any documents regarding its sales revenue for its B-GON products, nor did it introduce any documents relating to its advertising expenditures, nor did it introduce samples of its advertising or promotional displays." Brief at p. 20. Applicant points out that opposer only relied on the testimony of Mr. Miranda, "who testified that he only reviewed [a]dvertising [e]xpenditures from 1999-2002 to prepare for his deposition"; and "did not talk with anyone … to prepare for his deposition." *Id*.

Applicant's challenge to opposer's reliance on Mr. Miranda's testimony is not well taken. Mr. Miranda is a brand manager for opposer, and his duties "include developing and executing marketing plans, promotional plans, career development in terms of advertising, new product development, and profit and loss statement[s]." Miranda tr. at pp. 6-7. In view of his duties, there is no reason to question the sales revenue and advertising expenditures to

which he testified.[21] Thus, while opposer has not introduced documentary evidence in support of its sales revenue and advertising expenditures, its failure to do so does not defeat its contention that the B-GON marks are famous. Further, applicant's contention that "[s]ales numbers alone are not sufficient to establish the fame of a mark" is of no moment – opposer has not relied only on sales numbers.

Thus, the factor of fame is resolved in opposer's favor, but only with respect to the WEED-B-GON mark.

Number And Nature Of
Similar Marks In Use On Similar Goods

Pursuant to a notice of reliance, applicant has introduced into evidence twenty-two third-party registrations taken from the Trademark Electronic Search System (TESS) for marks which incorporate the formative "BE-GONE" or "B-GONE" for what applicant characterizes as "various consumer products, many of which would be found in the stores that sell lawn and garden products such as [applicant's] products."[22] Brief at p. 15. It is well

[21] We note opposer's contention set forth on p. 9 of its reply that opposer did produce documents during the discovery period concerning its advertising and sales figures, and that applicant did not challenge Mr. Miranda's testimony during his testimonial deposition.

[22] Applicant has also, pursuant to a notice of reliance, introduced into evidence TESS copies of various trademark applications for marks containing the formative "BE GONE" or "B GONE." We give no further consideration to these applications because applications serve only as evidence that the applications

established that third-party registrations, by themselves, are entitled to little weight on the question of likelihood of confusion. *In re Hub Distributing, Inc*., 218 USPQ 284 (TTAB 1983). Third-party registrations are not evidence of what happens in the marketplace, or that the public is familiar with the use of such marks. *AMF Inc. v. American Leisure Prods., Inc*., 474 F.2d 1403, 177 USPQ 268 (CCPA 1973). Moreover, the various goods and services which the third-party registrations list are unrelated to applicant's goods. See, e.g., Registration No. 2890193 for MONSTERS BE GONE for "bubble bath"; Registration No. 2660748 for TAT2 BE GONE for "providing plastic surgical cosmetic procedures, namely the removal of tattoos, vascular veins, age spots, scars and wrinkles"; and Registration No. 2634445 for DOO BE GONE for "cleaning preparations, namely, liquid cleaning products for removal of bird droppings."[23] In view of the foregoing, and because applicant's and registrant's goods are essentially identical, we resolve this *du Pont* factor in opposer's favor.

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were filed. *In re Phillips Van Heusen Corp*., 63 USPQ2d 1047 (TTAB 2002).

[23] Applicant also identified Registration No. 2157411 for FROST B-GONE and design, but Office records reflect that Registration No. 2157411 was cancelled on February 19, 2005. We therefore give no further consideration to Registration No. 2157411.

Absence Of Actual Confusion and Length of Time During and Conditions Under Which There Has Been Concurrent Use Without Evidence of Actual Confusion

Applicant maintains that EASYGONE products are only sold at OSH stores, numbering approximately eighty-five stores throughout California. Vogelgesang tr. at pp. 11 and 22. Opposer's goods under opposer's involved marks are also sold at OSH stores, and some of opposer's and applicant's goods are sold in close proximity to each other. Mr. Yeager, whose responsibilities include the business management, marketing and strategic planning of EASYGONE products, testified that no one at OSH has reported to him any confusion between EASYGONE and any B-GON product. Yeager tr. at pp. 6, 13 and 64. Opposer maintains too that it is unaware of any instances of actual confusion. Response to applicant's Interrogatory No. 42.

While there is no evidence of actual confusion, this fact does not indicate that there is no likelihood of confusion. The absence of actual confusion does not mean there is no likelihood of confusion. *Giant Food, Inc. v. Nation's Foodservice, Inc*., 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983); *J & J Snack Foods,* 18 USPQ2d at 1892. Additionally, the record does not reflect how long both parties' goods have been sold concurrently at OSH and the extent of sales of EASYGONE goods. Thus, to the extent that

this factor is probative, it is neutral and not resolved in favor of either party.

Applicant's Survey

Applicant commissioned a survey to "determine whether or not there is a likelihood of confusion of source or affiliation among consumers in the relevant market concerning [opposer's] marks WEED-B-GON [and] BUG-B-GON, with [applicant's] mark EASYGONE." Survey Report, Exhibit 10 to Cogan tr. (hereinafter "Exhibit 10.") The survey concluded that there was no likelihood of confusion between EASYGONE and WEED-B-GON, and EASYGONE and BUG-B-GON.

The survey was conducted by Dr. Cogan, who has an MBA in marketing and a doctorate degree in business administration. Cogan tr. at pp. 7–8. Over the course of her career, Dr. Cogan estimates she has conducted over four hundred surveys, of which at least one hundred and fifty surveys have involved trademark or unfair competition issues. Cogan tr. at pp. 12-16. Additionally, Dr. Cogan has been designated as a survey expert in fourteen federal court actions and four state court actions. Cogan tr. at pp. 14–15.

The survey conducted by Dr. Cogan was a "mall intercept" survey designed to recreate the marketplace. Cogan tr. at p. 42. Dr. Cogan conducted two product line-up surveys in malls located in West Covina, California;

Ontario, California; Orland Park, Illinois; Lombard, Illinois; and Bradenton, Florida. According to Dr. Cogan, the two malls in California were chosen because of the availability of EASYGONE products in the area; and the malls in Illinois and Florida were chosen because they are "areas with strong gardening activity and good sales of OMS' WEED-B-GON and BUG-B-GON products." Cogan tr. at pp. 20-21.

Potential respondents were screened in order to participate in the survey. They were deemed qualified if they were over eighteen years of age, lived less than one-hundred miles from the mall interviewing location and had a home lawn or garden which they cared for in the past year. Further, they must have purchased any lawn weed killer or any lawn and garden insect killer in the past. Exhibit 10 at p. DEF 3004.

In the first product line-up – identified as the weed control survey – one hundred survey respondents were shown two displays of lawn weed killers. The respondents first viewed a container of opposer's WEED-B-GON. After they finished viewing the container, it was covered. Next, the survey respondents were shown a display of three lawn weed killer containers; EASYGONE, and two control brands, i.e., ADVANCED Lawn All-In-One Weed Killer for Lawns, and WEED

STOP Weed Killer for Lawns ("Weed Stop").[24] According to applicant, ADVANCED and WEED STOP were selected because "they are major brands that have products with the same functions as the WEED-B-GON lawn weed killer product and the EASYGONE lawn weed killer product." Brief at p. 36.

In the second product line-up, another hundred survey respondents were shown two displays of insect killers. The respondents first saw a container of BUG-B-GON. After they finished viewing the container, it was covered. Next, the survey respondents were shown a second display which included three yard and garden insect killers, i.e., EASYGONE, and two "control brands," namely, ADVANCED Garden Power Force Multi-Insect Killer and BUG STOP Multi-Purpose Insect Control Concentrate. Applicant maintains that these brands were selected because "they are major brands that have products with the same functions as the BUG-B-GON Garden and Landscape Insect Killer product and the EASYGONE Multi Purpose Yard and Garden Insect Killer product." Brief at p. 37.

After the respondents had a chance to view the second displays, each respondent was asked:

> Do you think any of these (lawn weed killers) or (lawn and garden insect killers) is made by the same company as the company which makes the (lawn weed killer) or (lawn and garden insect killer) you just saw?

[24] The purpose of including the "control brands was to measure the level of survey "noise" or respondent "guessing."

Twenty-five persons in the weed killer survey answered "yes" and twenty persons in the insect killer survey answered "yes," for a total of forty-five persons who said "yes." The forty-five persons who said "yes" then were asked the following question:

> Which of these (lawn weed killers) or (lawn and garden insect killers) do you think is made by the same company which makes the (lawn weed killer) or lawn and garden insect killer) you saw first?

Eight of the two hundred survey respondents selected EASYGONE, twelve selected ADVANCED Lawn/ADVANCED Garden and twenty-nine selected WEED STOP/BUG STOP. Exhibit 10, pp. DEF 3005–3007.

When these eight respondents who selected EASYGONE were asked why they thought WEED-B-GON or BUG-B-GON and EASYGONE were products made by the same company, "only one mentioned that the names sounded similar. Others mentioned the style, designs, colors, the handle, the bottle shape and that OSH is a store brand that is contracted out to someone else." Exhibit 10, p. DEF 3010.

Next, Dr. Cogan asked "follow-up assessment questions … to provide respondents with sufficient opportunity to voice an opinion regarding a relationship between EASYGONE and WEED-B-GON." Brief at p. 34. Specifically, respondents were asked:

> Do you think any of these (lawn weed killers) or (lawn and garden insect killers) is licensed by,

> sponsored by, or connected in any way with the company which makes the (lawn weed killer) or (lawn and garden insect killer) you saw first?

Twenty-four respondents in each survey (weed killer and insect killer) responded "yes."[25] They then were asked the following question:

> Which of these (lawn weed killers) or (lawn and garden insect killers) do you think is licensed by, sponsored by, or connected with the company which makes the (lawn weed killer) or (lawn and garden insect killer) you saw first?

Five respondents identified EASYGONE in the weed killer survey and seven respondents identified EASYGONE in the insect killer survey. Exhibit 10, p. DEF 3043.

From the foregoing, applicant concludes:

> In the Weed-Control survey, six percent of the respondents thought there was a source affiliation between EASYGONE and WEED-B-GON. This is less than the background noise level of fourteen percent for the control brands. In the Bug-Control Survey, nine percent thought there was a source affiliation between EASYGONE and BUG-B-GON. Again, this is less than the background noise level of 13.5% for the control brands. Accordingly, there is no likelihood of confusion between EASYGONE and WEED-B-GON or BUG-B-GON.
>
> … If the results of the Weed-Control and the Bug-Control surveys are combined, a total of fifteen respondents out of the total two-hundred respondents, or 7.5%, thought that EASYGONE was made by the same company that made WEED-B-GON and BUG-B-GON. Out of the fifteen, only one person gave a reason for the confusion [which] was the similarity of the names. The level of confusion

[25] According to applicant, by asking this question, applicant "was bending over backwards to find out if any confusion existed in the marketplace between EASYGONE and WEED-B-GON." Brief at p. 34.

> found by the survey is less than the average noise level of 13.7%.
>
> In *Helene Curtis Indus., Inc. v. Suave Shoe Corp*., 13 USPQ2d 1618 (TTAB 1989), this Board noted that a 7.6 percent level of confusion is not significant, while surveys disclosing a likelihood of confusion in the range of 11 percent to 25 percent have been found to be significant. Accordingly, the results of this survey show a de minimus level of confusion between EASYGONE and WEED-B-GON/BUG-B-GON. (Citations omitted. Underlining in original.) Brief at pp. 38-39.

We find that the survey is flawed in that the stimulus used is one not suited for Board proceedings where the issue in question is the registrability of the mark depicted in the drawing. Specifically, applicant showed respondents containers containing a variety of wording, shapes, colors and trade dress. Applicant's marks and opposer's marks were not displayed prominently, other marks were on the containers, and the marks at issue here were subordinated to other house marks and source indicators, which undoubtedly influenced the responses. Further, opposer has noted that the "EASYGONE container in each instance is shorter than all three other containers; it is a bright white color as compared to the dark colors of the other three containers; and the EASYGONE containers are formed to make a closed handle, where none of the other three containers are."[26]

[26] Opposer has also challenged the survey on the basis that the survey is in reality two surveys with sample sizes too small to be of any value; and that omitting respondents who responded "don't know" and persons who did not speak English from further questioning was in error.

Reply at p. 18. Applicant's mark is in standard character form, thus the stimulus should also have been in standard character form. See *Miles Laboratories Inc. v. Naturally Vitamin Supplements Inc.*, 1 USPQ2d 1445 (TTAB 1986) ("In the case before us, we have already held that the issue we have to decide concerns only the likelihood of confusion of the terms VIT-A-DAY and SUPER VIT-A-DAY with ONE A DAY, without regard to any special form of lettering or design features which may, in fact, be currently associated with either of those word marks in the marketplace. Accordingly, using the card on which the mark is displayed in block letters was the only appropriate stimulus available to the survey designer."). See also *Carl Karcher Enterprises, Inc. v. Stars Restaurants Corp.*, 35 USPQ2d 1125 (TTAB 1995). Applicant's methodology was better suited for a survey for trademark infringement litigation. Therefore, the survey has extremely limited probative value in determining whether there is a likelihood of confusion in this case.

Applicant's Intent

Applicant maintains as follows:

> [T]he evidence of record shows that Applicant is not simply a competitor who has stumbled upon an infringing mark. Instead, Applicant is a former distributor of the B-GON products which lost its right to sell those products in connection with Opposer's acquisition of the marks from their former owner. As such, Applicant had knowledge of the large volume of sales and great success

> enjoyed by the B-GON products, and had every motivation to ensure that the new house brand names it wanted to develop would likewise enjoy similar success. In this case, therefore, the issue of intent is relevant, and it weighs heavily in Opposer's favor. (Citations omitted.) Brief at p. 21.

Opposer also cites, among other things, as evidence of applicant's alleged bad faith to the fact that when a T&T search was commissioned, it was for EASY GON rather than EASYGONE or EASY GONE, with GON spelled the same as GON in opposer's marks.

We are unpersuaded from the evidence before us that applicant had any bad intent in adopting EASYGONE. Applicant sought to develop a line of value products prior to the termination of its distributorship relationship in 1999, retained naming companies to aid in the selection of a trademark (and a naming company, not applicant, came up with EASYGONE), commissioned a T&T search (although for the phonetic equivalent EASY GON) which was reviewed by one of its trademark attorneys and commissioned a research firm to determine the impression EASYGONE would have on potential consumers. Vogelgesang tr. at pp. 61, 83. Also, applicant conducted its own in-house testing of EASYGONE and it was OSH, not applicant, who chose the mark for the value line of products to be sold in OSH’s stores, which choice was approved by Excel Marketing.

Conclusion

In view of the foregoing, we find that opposer has established a likelihood of confusion between opposer's WEED-B-GON mark and applicant's EASYGONE mark, particularly because there is some evidence of fame of the WEED-B-GON mark. We also find because opposer has established that BUG-B-GON is a strong mark, that confusion is likely between opposer's BUG-B-GON mark and applicant's EASYGONE mark. However, with the remaining marks, i.e., BRUSH-B-GON, GRASS-B-GON and ANT-B-GON, which have not been widely advertised and whose underlying goods have not had the commercial success applicant's other marks have had, we find that opposer has not established a likelihood of confusion between such marks and applicant's EASYGONE mark.

Dilution

The parties have not addressed opposer's dilution claim in their briefs. Accordingly, and in view of our determination that applicant's mark is likely to cause confusion with opposer's WEED-B-GON and BUG-B-GON marks, we need not reach opposer's dilution claim.

DECISION: The opposition is sustained on the basis of likelihood of confusion under Section 2(d) and registration to applicant is refused.